

II. Claim rejections under 35 U.S.C. § 103(a)

Claims 1 - 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,093,108 to Pappas et al. ("*Pappas*") in view of U.S. Patent No. 5,212,214 to Kallenbach ("*Kallenbach*"). Applicants respectfully traverse this rejection for the reasons of record as well as those below.

In response to the arguments set forth in Applicants' Response filed December 20, 2001, the Examiner merely asserts that "*Pappas* ('108) and *Kallenbach* ('214) are within the same field of endeavor, because the references teach coating a surface or a substrate." See page 3 of the present Office Action.

As a preliminary matter, Applicants respectfully remind the Examiner that if a rejection is maintained in view of Applicants' arguments, the Examiner should take note of Applicants' arguments and answer the substance of them. See M.P.E.P. § 707.07(f). Applicants therefore request that the Examiner fully address each and every argument as dictated by the M.P.E.P., should the Examiner choose to maintain the rejection.

Further, Applicants fail to see the relevance of the Examiner's statement to the issue at hand. Specifically, as explained in the Response filed December 20, 2001, the Examiner has not established a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must demonstrate that there was some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine

reference teachings, and demonstrating that there was a reasonable expectation of success. See M.P.E.P. § 2143. These criteria must be met **whether or not** the references relied upon by the Examiner are within the same field of endeavor. In the present case, these two criteria have not been met and therefore the Examiner has failed to make a *prima facie* case of obviousness for at least this reason.

The arguments discussed in the Response filed December 20, 2001 will not be repeated herein. However, Applicants note that, although *Pappas* and *Kallenbach* may both relate to coating a substrate, one of ordinary skill in the art still would not have been motivated to use *Kallenbach's* composition in the nail enamel composition taught by *Pappas*. For example, *Kallenbach* relates to compositions for coating a substrate that is subsequently cured at a temperature ranging from about 315°C to about 470°C. See col. 9, lines 23-32. *Pappas's* compositions are not cured but rather "dry in a period no greater than three minutes" "at room temperature." See Abstract, col. 14, lines 29-32. Further, there would be no motivation to use *Kallenbach's* composition on the human nails taught as substrates in *Pappas*. In contrast, the fact that *Kallenbach's* compositions are cured at a temperature of at least 315°C would teach away from the use of these composition on human nails. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See M.P.E.P. § 2143.01. Accordingly, for at least the foregoing reasons, one of ordinary skill in

the art would not have been motivated to make the modification proposed by the Examiner.

Thus, Applicants maintain that a *prima facie* case of obviousness has not been established and respectfully request the withdrawal of this rejection.

### III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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